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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,071	12/21/2001	Takeshi Yagi	1113-017/MMM	5313

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Ipsolon LLP  
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EXAMINER

SHEINBERG, MONIKA B

ART UNIT PAPER NUMBER

1634

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/029,071	YAGI, TAKESHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Monika B Sheinberg	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 6 is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1 sheet</u> . | 6) <input checked="" type="checkbox"/> Other: <i>Detailed Action</i> .      |

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**DETAILED ACTION**

**Election/Restrictions**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121: ✓
  - I. Claims 1-11, drawn to a semiconductor device, classified in class 438, subclass 16.
  - II. Claims 12-16, drawn to a method for measuring organic molecules, classified in class 435, subclass 6.
  - III. Claims 17-21, drawn to a method of manufacturing a semiconductor device, classified in class 438, subclass 29.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of measuring organic molecules can be practiced by hand or by other materially different apparatuses such as a hybridization membrane or a microarray.

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of Invention I does not require the “forming” steps required by the method of Invention II. In contrast, the product of Invention I can be made as merely a photoelectric converter, which has a surface, i.e. deposition region.

Inventions II and III are different and distinct. Inventions are different and distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the method of Invention III does not require molecule “fixing” steps nor sample “placing”, “irradiating”, or “detecting” steps that are required of

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Invention II. In contrast, the method of Invention II required material “forming” steps that define areas on a surface.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III or IV; restriction for examination purposes as indicated is proper.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.3.12.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 USC 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 USC § 103(b),” 1184 OG 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 USC 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See § 804.21.

**Telephone Election**

4. During a telephone conversation with Mark Meininger on September 29, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

- Claims 1-11 are hereby examined.

**Priority**

5. The claim for foreign priority to Japanese Patent has not been considered due to no translation having been provided. As such, the priority date is considered to be December 21, 2001.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3, 4, 6, 7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 4 and 6 are indefinite due to the lack of clarity of the acronym "CCD". The full name must appear at least once followed by the acronym in parentheses prior to use of acronym; i.e. charge coupled device (CCD). As such claims 7 and 9 are also indefinite due to dependency from claim 6.

Claims 3 and 4 are vague and indefinite due to the lack of clarity of that which is to be described by "CCD potential well" (line 4). It is unclear as to what is the difference between the

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recesses (labeled 112) in the substrate versus the “potential CCD wells” (claims 3 and 4) or a “potential well of the pixel” (specification, p.8 [0040]). Due to the lack of clarity of that which are CCD potential wells, the thickness of the semiconductor substrate is unclear.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hollis *et al.* (US Patent 5,846,708; 08-Dec-1998; PTO-1449).

Figures 15 and 16 and columns 8 (line 58) to column 9 (line 65) of Hollis *et al.* teach a semiconductor element (claims 1-4) that makes up a semiconductor device (claims 5-11), wherein the following limitations are taught:

With respect to claims 1, 5 and 6, Hollis *et al.* teaches a substrate having a side wherein recesses are for an organic molecule probe disposition region (hybridized DNA) and the opposing side having a CCD region in alignment (claim 5) with the probe disposition region to perform optical imaging functions (claim 6) just as in the instant application, Figure 1 region 110.

With respect to claims 2, 7 and 10, Hollis *et al.* teaches the optical filter layer corresponding to the probe disposition region that blocks the excitation of light (col. 9 lines 45-53).

With respect to claims 3 and 4, Figure 15 displays the thickness of the semiconductor substrate between the probe disposition region and the CCD region is equivalent to the depth of the recesses (or wells 230).

With respect to claims 8, 9 and 11, Figures 15 and 16 display a plurality of recesses or wells on the probe disposition region of the semiconductor substrate.

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**Claim Objections**

8. Claims 3, 4 and 6 are objected to due to the acronym CCD.

**Conclusion**

- Election of Group I (claims 1-11).
- Claims 3, 4, 6, 7 and 9 are rejected under 35 U.S.C. 112, second paragraph.
- Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hollis *et al.*
- Claims 3, 4 and 6 are objected.

No claim is allowed.

**Inquiries**

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monika B. Sheinberg, whose telephone number is (703) 306-0511. The examiner can normally be reached on Monday-Friday from 9 A.M to 5 P.M. If attempts to reach the examiner by telephone are unsuccessful, the primary examiner in charge of the prosecution of this case, Jehanne Souaya, can be reached at 703-308-6565. If attempts to reach the examiners are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Chantae Dessau, whose telephone number is (703) 605-1237, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

October 17, 2003  
Monika B. Sheinberg  
Art Unit 1634

*MBS*

JEHANNE SOUAYA  
PATENT EXAMINER

Primary

*Jehanne Souaya*  
10/17/03